UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Ex parte SOUJI KIHIRA

Appeal No. 2006-0677
Application No. 10/713,105

HEARD: MARCH 21, 2006

Before HAIRSTON, RUGGIERO, and BLANKENSHIP, Administrative Patent Judges.

RUGGIERO, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on the appeal from the final rejection of claims 1-6, which are all of the claims pending in the present application.

The claimed invention relates to a shielded wire harness which includes a tube-shaped shielding member configured to enclose a plurality of wires collectively. More particularly, the tube-shaped shielding member includes a main shield portion made of a

substantially rigid metal pipe and a sub-shield portion formed shorter than the main shield portion and configured to be deformable.

Claim 1 is illustrative of the invention and reads as follows:

1. A shielded wire harness comprising:

a plurality of wires;

a plurality of wire-side terminals respectively connected to end portions of the wires, and configured to be connected to respective terminals disposed within a shield case of an equipment; and

a shielding member formed in a tube shape and configured to enclose the plurality of wires collectively and to be connected to the shield case,

wherein the shielding member comprises a main shield portion made of a substantially rigid metal pipe, and a sub-shield portion formed shorter than the main shield portion and configured to be deformable.

The Examiner relies on the following references:[1]

Lawson et al. (Lawson)	3,280,246	Oct. 18, 1966
Morgan et al. (Morgan)	5,473,117	Dec. 05, 1995

Claims 1-6 stand finally rejected under 35 U.S.C. § 103(a). As evidence of obviousness, the Examiner offers Appellant's admitted prior art in view of Morgan with respect to

[1] In addition, the Examiner relies on Appellant's admissions as to the prior art at pages 1 and 2 of the specification.

claims 1-3, 5, and 6, and adds Lawson to the basic combination with respect to claim 4.[2]

Rather than reiterate the arguments of Appellant and the Examiner, reference is made to the Briefs[3] and Answer for the respective details.

OPINION

We have carefully considered the subject matter on appeal, the rejection advanced by the Examiner and the evidence of obviousness relied upon by the Examiner as support for the rejection. We have, likewise, reviewed and taken into consideration, in reaching our decision, Appellant's arguments set forth in the Briefs along with the Examiner's rationale in support of the rejection and arguments in rebuttal set forth in the Examiner's Answer.

It is our view, after consideration of the record before us, that the evidence relied upon and the level of skill in the particular art would not have suggested to one of ordinary skill in the art the invention as set forth in claims 1-6. Accordingly, we reverse.

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[2] As indicated at page 3 of the Answer, the Examiner has withdrawn the 35 U.S.C. § 112, first paragraph, rejection of claims 1-6.

[3] The Appeal Brief was filed June 23, 2005. In response to the Examiner's Answer mailed July 27, 2005, a Reply Brief was filed September 27, 2005, which was acknowledged and entered by the Examiner as indicated in the communication mailed November 21, 2005.

In rejecting claims under 35 U.S.C. § 103, it is incumbent upon the Examiner to establish a factual basis to support the legal conclusion of obviousness. See In re Fine, 837 F.2d 1071, 1073, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). In so doing, the Examiner is expected to make the factual determinations set forth in Graham v. John Deere Co., 383 U.S. 1, 17, 148 USPQ 459, 467 (1966), and to provide a reason why one having ordinary skill in the pertinent art would have been led to modify the prior art or to combine prior art references to arrive at the claimed invention. Such reason must stem from some teaching, suggestion or implication in the prior art as a whole or knowledge generally available to one having ordinary skill in the art. Uniroyal Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 1051, 5 USPQ2d 1434, 1438 (Fed. Cir.), cert. denied, 488 U.S. 825 (1988); Ashland Oil, Inc. v. Delta Resins & Refractories, Inc., 776 F.2d 281, 293, 227 USPQ 657, 664 (Fed. Cir. 1985), cert. denied, 475 U.S. 1017 (1986); ACS Hosp. Sys., Inc. v. Montefiore Hosp., 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). These showings by the Examiner are an essential part of complying with the burden of presenting a prima facie case of obviousness. Note In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992).

With respect to the Examiner's 35 U.S.C. § 103(a) rejection of appealed independent claim 1 based on the combination of the admitted prior art and Morgan, Appellant asserts that the Examiner has failed to establish a prima facie case of obviousness since all of the claimed limitations are not taught or suggested by the applied prior art references. After reviewing the arguments of record from Appellant and the Examiner, we are in general agreement with Appellant's position as stated in the Briefs.

Initially, we agree with Appellant (Brief, pages 9 and 10; Reply Brief, page 4) that the cable shield structure of the admitted prior art does not have a shielding member with a substantially rigid metal pipe main portion and a shorter deformable sub-shield portion. Contrary to the Examiner's assertion (Answer, page 10), merely because the claimed shielding member and the combination flexible shield/armored case of the admitted prior art both function to protect a cable against interfering objects such as bounced stones, this does not mean they have the same structure.

We further agree with Appellant that, although the Examiner has applied the Morgan reference to overcome the lack of explicit disclosure of a shielding member with a substantially rigid main shield portion in the admitted prior art, we find no such

substantially rigid shielding structure in Morgan. We find no basis for the Examiner's assertion (Answer, page 11) that the shielding members 14 and 16, described as foil shields, have a substantially rigid structure as claimed. In our view, as also argued by Appellant (Brief, pages 11-13; Reply Brief, pages 2 and 3), the ordinarily skilled artisan would recognize a foil shield as being a thin, flexible structure, and not one that is "substantially rigid."

With the above discussion in mind, it is apparent to us that even assuming, arguendo, that a proper basis exists for the combination of the admitted prior art and Morgan, the ensuing structure would not result in a shielding member with a substantially rigid main shield portion and a shorter flexible sub-shield portion as claimed. We have also reviewed the Lawson reference applied by the Examiner to address the plated connection pipe feature of dependent claim 4. We find nothing in the disclosure of the Lawson reference which would overcome the innate deficiencies of the admitted prior art and Morgan discussed supra. Accordingly, since we are of the opinion that the Examiner has not established a prima facie case of obviousness since all of the claimed limitations are not taught or suggested by the applied admitted prior art and Morgan references, we do not sustain the

rejection of independent claim 1, nor of claims 2-6 dependent thereon.

In summary, we have not sustained the Examiner's 35 U.S.C. § 103(a) rejection of any of the claims on appeal. Therefore, the decision of the Examiner rejecting claims 1-6 is reversed.

REVERSED

KENNETH W. HAIRSTON)
Administrative Patent Judge)
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JOSEPH F. RUGGIERO) BOARD OF PATENT
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HOWARD B. BLANKENSHIP)
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